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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,488	10/20/2003	Jay V. Clark	1165.54USC6	6517

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EXAMINER	
CHENG, JOE H	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,488	CLARK ET AL.	
	Examiner	Art Unit	
	Joe H. Cheng	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-112* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-112* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/20/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the Preliminary Amendment filed on October 26, 2003, claims 1-40 have been cancelled, and the newly added claims 41-112 are pending.

Specification

2. The disclosure is objected to because of the following informalities:

The term "This is a continuation of application Serial No. 10/425,775, filed April 29, 2003, which is continuation of application Serial No. 09/660,204, filed September 12, 2000, now U.S. Patent No. 6,558,166 B1, which is a continuation of application Serial No. 09/141,804, filed on August 28, 1998, which is now U.S. Patent No. 6,168,440 B1, which is a continuation of application Serial No. 09/003,979, filed on January 7, 1998, now abandoned, which is a continuation of application Serial No. 08/561,081, filed November 20, 1995, which is now U.S. Patent No. 5,735,694, which is a continuation of application Serial No. 08/290,014, which is now U.S. Patent No. 5,558,521 filed August 12, 1994, which is a division of application Serial No. 08/014,176, Filed February 5, 1993, now U.S. Patent No. 5,437,554. U.S. Patent No. 5,437,554, U.S. Patent No. 5,718,591, and U.S. Patent No. 6,193,521 are hereby incorporated by reference in their entirety." on page 1, line 1 should be recited as --This is a continuation of application Serial No. 10/425,775, filed April 29, 2003, which is continuation of application Serial No. 09/660,204, filed September 12, 2000, now U.S. Patent No. 6,558,166 B1, which is a continuation of application Serial No. 09/141,804, filed on August 28, 1998, which is now U.S. Patent No. 6,168,440 B1, which is a continuation of application Serial No. 09/003,979, filed on January 7, 1998, now abandoned, which is a continuation of application Serial No. 08/561,081,

filed November 20, 1995, which is now U.S. Patent No. 5,735,694, which is a continuation of application Serial No. 08/290,014, which is now U.S. Patent No. 5,558,521 filed August 12, 1994, which is a division of application Serial No. 08/014,176, Filed February 5, 1993, now U.S. Patent No. 5,437,554; application Serial No. 09/143,303, filed on August 28, 1998, now U.S. Patent No. 6,193,521 B1, which is a continuation of application Serial No. 09/003,979, filed on January 7, 1998, now abandoned, which is a continuation of application Serial No. 08/561,081, filed on November 20, 1995, now U.S. Patent No. 5,735,694, which is a continuation of application Serial No. 08/290,014, filed on August 12, 1994, now U.S. Patent No. 5,558,521; and application Serial No. 08/561,083, filed on November 20, 1995, now U.S. Patent No. 5,718,591, which is a continuation of application Serial No. 08/290,014, filed on August 12, 1994, now U.S. Patent No. 5,558,521, are hereby incorporated by reference in their entirety.--, so as to clarify the status.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 86-88 and 110-112 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The antecedent basis for "the second scoring rate" and "the first scoring rate" (as per claims 86 and 110) has not been clearly set forth. In addition, claims

87, 88, 111 and 112 are rejected for incorporating the above errors from their respective parent claims by dependency.

Claim Rejections - 35 USC § 103

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Double Patenting

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 65-88 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-48 of U.S. Patent No. 6,193,521 B1 (hereinafter as Clark et al'521 B1). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitations of the "resolver's performance in evaluating data items" or "evaluation of the data items", the "test-scoring validity level", and "an evaluation result for a quality item" are the obvious alternative languages since these merely describe the "test resolver's performance in

scoring test answers" or "scoring of test answers", the "test-scoring validity level", and "a test score for a quality item" (as per claims 25-48 of Clark et al'521 B1) in boarder terms. Hence, the instant claim does not differ from the scope of the patented claims 1-4. In 214 USPQ 761, *In re* ***Van Ornum*** and ***Stang***, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

10. Claims 89-112 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,718,591 (hereinafter as Clark et al'591). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitations of the "resolver's performance in evaluating data items" or "evaluation of the data items", the "test-scoring validity level", and "an evaluation result for a quality item" are the obvious alternative languages since these merely describe the "test resolver's performance in scoring test answers" or "scoring of test answers", the "test-scoring validity level", and "a test score for a quality item" (as per claims 1-24 of Clark et al'591) in boarder terms. Hence, the instant claim does not differ from the scope of the patented claims 1-4. In 214 USPQ 761, *In re* ***Van Ornum*** and ***Stang***, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

11. Claims 41-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,193,521 B1 (hereinafter as Clark et al'521 B1) in view of Shapiro (U.S. Pat. No. 4,785,472). It is noted that the teaching of Clark et al'521 B1 does not specifically disclose the distributed computer network (as per claims 41-48, 50-52 and 54-64) as required. However, Figs. 1-4 of Shapiro teaches that such feature of the distributed computer network (seer the abstract) is old and well known, and is considered an arbitrary obvious design choice. Hence, it would have been obvious to one of ordinary skill in the art to modify the system of Clark et al'521 B1 with the feature of the distributed computer network as taught by Shapiro as both Clark et al'521 B1 and Shapiro are directed to the system and method for electrically providing performance feedback based upon a comparison of a resolver's performance in evaluating data items to predetermined performance criteria, so as to provide the evaluated performance over the computer network.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (703)308-2667. The examiner can normally be reached on Tue.- Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703)308-1327. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Joe H. Cheng
Primary Examiner
Art Unit 3713

Joe H. Cheng
March 26, 2004